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EXAMINER

MOORE, MARGARET G

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/827,480	Applicant(s) FECHT ET AL.	
	Examiner Margaret G. Moore	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4 to 7, 9, 11 to 14 is/are pending in the application.
- 4a) Of the above claim(s) 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 to 7, 9, 11, 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/19/04, 12/6/10</u> | 6) <input type="checkbox"/> Other: _____ |

1. This office action is in response to applicants' Appeal Brief filed 12/6/10. Please note that this application has been transferred and is currently being examined by Examiner Margaret Moore. The current examiner apologizes for what may seem to the be office's delay in prosecuting this application, as applicants have filed two different Appeal Briefs in this case only to have prosecution be reopened. While this examiner does not believe the previous prior art rejections to be improper, she does believe that there are closer references, i.e. anticipatory references, which should be cited in this application. Note the new grounds of rejection below.

WO 95/23579 (cited by applicants in an IDS) shows a siloxane meeting formula (i) that is known in the art and has been commercially available to quite a while (since this reference is well over 25 years old). Specifically pages 41 and 42 show a siloxane X-22-160AS meeting (i) in claim 1 as well as the limitations in claims 2 and 4 to 7. From this, and the fact that the assignee in the application is a leading manufacturer of siloxane polymers, the Examiner assumes that applicants are aware of commercially available siloxanes meeting component (i). Applicants could significantly assist and expedite prosecution of this application by divulging the names of other commercially available, or known, siloxanes that meet the requirements of (i).

The Examiner notes that component (ii) in the claims is extremely broad. It is not broad in the sense that it is indefinite but rather it is broad in that it includes numerous compounds, thousands perhaps. Applicants are reminded that prior art references need not refer to the an ingredient as a cosmetic, household care or health care ingredient for it to meet this requirement. The Examiner also notes that there is nothing in the claims that prevents the compound (ii) from being reactive with the compound (i). Furthermore the term "comprising" allows for the presence of any additional component in the claimed composition. With this in mind, please note the following new grounds of rejection.

2. It appears that the claims under examination are those that were filed 6/10/2008. The Examiner notes that the top of the pages for this set of claims refers to Appl. No. 10/827,478 rather than the actual application 10/827,480. Applicants are requested to

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refer to the proper serial number in future communication to avoid any confusion or mishandling of the papers.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 4 to 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Takao et al.

Takao et al. teach a thermal transfer image receiving sheet that includes a coating for a receptive layer. Please see column 10, solution 2) which includes X-22-160AS as well as methyl ethyl ketone, which is a cosmetically acceptable solvent. In this manner the solution in Takao et al. anticipates both components (i) and (ii) in claim 1.

With regard to claim 11, drawn to a cosmetic product, the Examiner notes that this product is defined solely by the composition and the composition is defined solely by components (i) and (ii). While Takao et al. do not refer to the composition as a cosmetic product, since the chemical formulations are exactly the same, this claim is anticipated as well.

6. Claims 1, 2, 4 to 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamori et al.

Yamamori et al. teach a paint composition that contains the siloxane X-22-160AS which meets claimed component (i). See for instance Example 3. This siloxane is in combination with a phthalic anhydride and, subsequently, hydroxy stearate. Both of these compounds can be considered a cosmetic, household care or health care "ingredient".

For claim 9, note that dibutyl tin oxide can be a pigment.

With regard to claim 11, drawn to a cosmetic product, the Examiner notes that this product is defined solely by the composition and the composition is defined solely by components (i) and (ii). While Yamamori et al. do not refer to the composition as a cosmetic product, since the chemical formulations are exactly the same, this claim is anticipated as well.

7. Claims 1, 2, 4 to 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ihara et al.

Ihara et al. teach a method of making a component for use as skin cosmetics and the like (abstract). Please see Examples 1 and 2 which show siloxanes meeting (i). The siloxanes are in combination with phosphorous oxychloride and tetrahydrofuran, both of which meet the requirement of (ii).

8. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ihara et al.

Ihara et al. teach that the organopolysiloxanes therein can be used in cosmetic compositions. From this one having ordinary skill in the art would have found the use thereof in a lipstick to have been obvious, as this is a common cosmetic composition. One having ordinary skill in the art would have been motivated to use the siloxanes therein in a lipstick in an effort to take advantage of the various properties and benefits associated therewith, as found in column 25, lines 1 to 15. This renders obvious claim 12.

In addition, since the composition therein is useful as a cosmetic, it would follow that the skilled artisan would have found the addition of a pigment to such a composition obvious. This renders obvious claim 9.

9. Claims 1, 2, 4 to 7 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Katsoulis.

Katsoulis teaches siloxane gels that are useful in personal care applications. As can be seen from the abstract, the composition contains a siloxane polyether as well as hydroxystearic acid and volatile siloxane, both of which meet the requirement for (ii).

As for claimed component (i), please see the formula on column 3, lines 15 to 20. The "s" value can be from 1 to 30. In view of the fact that patentees specifically delineate the value of 1 and in view of the limited selection for "s", one having ordinary skill in the art would have found an "s" value of 1 to be anticipated by Katsoulis. In this manner the resulting siloxane meets claimed component (i).

On the other hand, note for instance that the polymer (II) on column 7 differs from claimed (i) in that it contains a corresponding "s" value of 12 rather than 1. From the teachings on column 3, though, which indicates that any value within the range of 1 to 30 can be used, the skilled artisan would have found a corresponding value of "s" as 1 to have been obvious.

10. Claims 1, 2, 4 to 7 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Numao et al.

Numao et al. teach a coating solution. Please see Example 1 which mixes an aminosilane, which falls into the breadth of (ii) in claim 1, with X-22-160AS. This meets the requirements of the instant claims.

With regard to claim 11, drawn to a cosmetic product, the Examiner notes that this product is defined solely by the composition and the composition is defined solely by components (i) and (ii). While Numao et al. do not refer to the composition as a cosmetic product, since the chemical formulations are exactly the same, this claim is anticipated as well.

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11. Claims 1, 2, 4 to 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2-26634 (English language abstract).

JP 02-26634 teaches an electric viscous fluid that contains a hydrotarsite (which can be a pigment falling within the breadth of (ii) and claim 9), a silicone oil (which falls within the breadth of (ii) as well) and X-22-160AS. In this manner the composition prepared in the abstract anticipates the claims.

With regard to claim 11, the Examiner refers to the rejection rationale noted *supra*, as it presently applies.

12. Claims 1, 2, 4 to 7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al.

Kobayashi et al. teach a coating composition for pulp fiber. Please see Example 5 which shows a composition containing X-22-160AS and TOSPEARL 130, among other components, that meets the claimed component (ii). This anticipates the instant claims.

With regard to claim 11, the Examiner refers to the rejection rationale noted *supra*, as it presently applies.

13. Claims 1, 2, 4 to 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohgaki et al.

Ohgaki et al. teach a paint composition. Please see Preparation Example 6 on column 7 in which X-22-160AS is admixed with trimethylol propane, a common cosmetic ingredient. This anticipates the instant claims.

With regard to claim 11, the Examiner refers to the rejection rationale noted *supra*, as it presently applies.

For claim 9, note that dimethyl tin oxide can be a pigment. See also column 2, lines 20 and on.

14. Claims 1, 2, 4 to 7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemann et al.

The Examiner notes that this reference was cited in previous office actions.

Lemann et al. teaches a cosmetic composition that can be a lipstick. The composition contains various ingredients that meet (ii) and the pigment in claim 9. See for instance the teachings starting on the bottom of column 3.

With regard to component (i), please see the top of column 3. This shows a siloxane structure which is generic to the claimed component (i). Please note that "x" can be 1 and "y" can be 0. As this presently applies, patentees *specifically delineate* values of "x" and "y" that will result in the claimed siloxane. The skilled artisan need not pick and choose from various values of "x" and "y" in Lemann et al. that are not disclosed to arrive at the claimed invention. Rather one must merely select values of "x" and "y" that are specifically taught by Lemann et al. as being useful to arrive at the claimed siloxane.

It would have been within routine experimentation for one having ordinary skill in the art to select a siloxane having the smallest number of oxyalkylene units allowed, i.e. one in which "x" is 1 and "y" is 0. For instance if one wanted to assess the benefits and properties associated with the siloxane of general formula (I) in Lemann et al., one would be motivated select the various end points to use as comparison and/or to determine any trends in oxyalkylene selection.

With this in mind the Examiner agrees with the previous examiner's assessment that the claims are rendered obvious by the teachings in Lemann et al.

15. Claims 1, 2, 4 to 7, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima.

Nojima teaches a cosmetic composition that can be a lipstick. The composition contains various ingredients that meet (ii) and the pigment in claim 9. See for instance the teachings starting on column 3, line 50, through column 4.

With regard to component (i), please see the structure (3) on column 2. This shows a siloxane structure which is generic to the claimed component (i). Please note that "x2" can be 1 and "y2" can be 0. As this presently applies, patentees *specifically delineate* values of "x2" and "y2" that will result in the claimed siloxane. The skilled artisan need not pick and choose from various values of "x2" and "y2" in Nojima that are

not disclosed to arrive at the claimed invention. Rather one must merely select values of "x2" and "y2" that are specifically taught as being useful to arrive at the claimed siloxane.

It would have been within routine experimentation for one having ordinary skill in the art to select a siloxane having the smallest number of oxyalkylene units allowed, i.e. one in which "x" is 1 and "y" is 0. For instance if one wanted to assess the benefits and properties associated with the siloxane of general formula (I) in Nojima, one would be motivated select the various end points to use as comparison and/or to determine any trends in oxyalkylene selection.

On the other hand, please see the siloxane of formula (2) and specifically the working example on Table 5. This shows a "y1" value of 0. This siloxane differs from (i) in claim 1 only in that it contains from 7 to 15 ethoxy units. As shown on the bottom of column 2, though, this siloxane can have as little as 1 ethoxy unit. From this one having ordinary skill in the art would have been motivated to use a corresponding siloxane having an "x1" value of 1 rather than an "x1" value of 7 to 15 obvious.

With this in mind the claims are rendered obvious by the teachings in Nojima.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday, Tuesday and Friday, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1795

mgm
3/24/11